

Lawlor and has responded to Applicants' arguments contained in the amendment of May 8, 2000. Applicants respectfully traverse this rejection and the Response contained in the Final Office Action. In order to focus the examination of the present application, Applicants shall only traverse the points of the Final Office Action with which Applicants most strongly disagree. Applicants incorporate herein the arguments previously made in the amendment of May 8, 2000, and reserve the right to address the other responses contained in the Final Office Action should it become necessary.

With respect to the rejection of independent claim 1, Applicants strenuously disagree that Lawlor teaches the matching limitation of this claim. Claim 1 at lines 7-9 requires "matching the identified non-issuer account numbers with account numbers representing accounts issued by the issuer." Applicants in the previous amendment had argued that Lawlor does not teach or even suggest this limitation. In response to Applicants' argument, the Final Office Action states that "[f]igure 1 of Lawlor clearly shows a database which inherently has these capabilities." It is further stated that "[t]he inclusion of a database in Lawlor's invention clearly teaches the matching capabilities in applicant's claims ..."

Applicants respectfully submit that this basis of rejection cannot be maintained. Merely because Lawlor contains a database, does not mean that it suggests, let alone explicitly discloses (as required by § 102) the above recited matching limitation of claim 1. The rationale of this rejection, that Lawlor discloses a database, would mean that Lawlor anticipates any banking process that operates on account numbers (i.e., all banking processes). The method of claim 1 contains specific steps that are not "inherent" or taught by a system that contains a database. If there is a teaching in Lawlor with respect to the matching of issuer account numbers with non-issuer account numbers as required by claim 1, Applicants respectfully request a specific citation to this teaching.

The Final Office Action is essentially arguing that because the ATM system described in Lawlor accesses accounts from the issuing bank and from other banks that it "teaches" the method step of claim 1 of matching these two account numbers. Applicants must again stress

that Lawlor does not explicitly disclose this method step as required by § 102. Furthermore, there is no suggestion or motivation in Lawlor (or otherwise) to perform this method step. When the ATM system of Lawlor allows a user to access an account at a different bank, why would the system even attempt to match the account number at a different bank with an account number at the Lawlor's bank? Lawlor does not provide any suggestion or motivation to do so, nor is there any general suggestion or motivation on which the Office can rely.

As Applicants have shown that the rationale for the rejection of claim 1 over Lawlor cannot be maintained under § 103 let alone § 102, withdrawal of the Final Rejection of on the basis of Lawlor of claims 1-8 is respectfully requested.

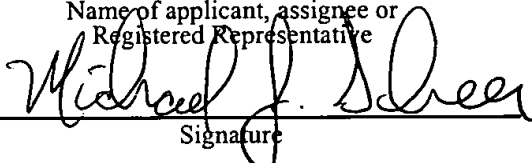
The Final Office Action has maintained the rejection of independent claim 10 on the basis of the Konya reference in view of Pascoe. Similar to independent claim 1, independent claim 10 requires "associating, by customer, the non-issuer account numbers with issuer account numbers." Konya, like Lawlor, discloses the well known ATM system in which a database is maintained that allows users to access their bank accounts from any ATM machine that is part of the system. The Final Office Action states that the ATM system of Konya "clearly reads on associating account numbers since matching information is inherent in a database." Again, Applicants strongly disagree with this conclusion of the Final Office Action. If an ATM card holder is attempting to withdraw funds from a bank account that is not held by the operator of the ATM machine, why would the bank operating the ATM machine try to even identify whether the card holder additionally has an account with the bank, let alone try and match the bank account with the user's other bank account? There is simply no motivation or suggestion in any of the references as to why one would perform the matching of independent claims 1 and 10.

Applicants reiterate that they still disagree with the original rejection of all of the remainder of the claims and disagree with the responses contained in the Final Office Action. In order to facilitate the prosecution of the present application, Applicants have focused on

the matching/associating steps of independent claims 1 and 10. Applicants have shown that these method steps of independent claims 1 and 10 (also included in independent claim 18) are neither taught nor suggested by the prior art of record. Applicants have further shown that the disclosure of a database in the ATM systems of Lawlor and Konya does not anticipate nor suggest the matching and associating steps of the independent claims.

Withdrawal of all of the rejections on the basis of prior art is therefore respectfully requested on the merits of the above arguments. As each of the claims of the present application are currently in condition for allowance, such action is earnestly solicited.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Asst. Commissioner for Patents, Washington, D.C. 20231, on October 17, 2000:

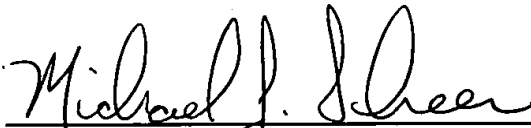
Michael J. Scheer
Name of applicant, assignee or
Registered Representative


Signature

October 17, 2000

Date of Signature

Respectfully submitted,



Michael J. Scheer
Registration No. 34,425
OSTROLENK, FABER, GERB & SOFFEN, LLP
1180 Avenue of the Americas
New York, New York 10036-8403
Telephone: (212) 382-0700

SIW/MJS:swu